

REMARKS

Claims 7, 8, 10, 11 and 18-21 remain pending the application. Claims 8, 11, 18-21 have been rejected under 35 U.S.C. § 102(b) as being anticipated by Shiraishi et al. (U.S.P. 4,617,468). Claims 7-8, 10-11, 18-21 have been rejected under 35 U.S.C. § 102(b) as being anticipated by Tsuchiya et al. (U.S.P. 5,672,514). Both references are assigned to Fuji Photo Film. Applicant respectfully submits the following arguments in traversal of the prior art rejections.

With regard to the rejection of independent claim 8 over Shiraishi, the Examiner essentially maintains the same basis of rejection and provides a few points in rebuttal. Applicant would submit that the Examiner's rejection and rebuttal are insufficient to maintain the rejection for at least the following three reasons.

First, most significantly, the Examiner contends that the management information described by the means for attaching management information and the means for obtaining information concerning the position of the probe is not relevant to patentability. The Examiner's rationale is incorrect. If the Examiner is construing the claims pursuant to Section 112, paragraph 6, the Examiner cannot ignore the recitations pertaining to the management information which describes a functional feature of the claim. In this regard, the Examiner is essentially disregarding the Decision on Appeal with regard to the functional requirements recited. See Decision on Appeal, page 6, last partial paragraph.

Second, similarly, the Examiner's response that the feature with regard to the marker is irrelevant to patentability is also in error. Because the marker is also part of the functional

recitation of the means for attaching, the Examiner cannot ignore the characteristics, such as the functional aspects, of the marker.

Applicant submits that the Examiner cannot selectively apply the analysis of Section 112, paragraph 6 to limit the structure and then ignore all the functional recitations that would permit a Section 112, paragraph analysis to apply in the first instance.¹

Third, the Examiner also contends that the electrophoresis analysis corresponds to “predetermined” locations based on size and weight of biological elements. However, the electrophoresis analysis does not comprise “management information” as described by claim 8.

Because claims 11 and 20-21 include recitations analogous to those of claim 8 as discussed for the first and third reasons above for claim 8. The remaining claims are patentable based on their dependency.

With regard to the rejection over Tsuchiya, this reference also relates to analysis of binding substances with a stimuable phosphor. A method of application of analysis samples includes pipeting the information to a substrate. However, Tsuchiya is also silent with regard to the attachment of management information. Therefore, the claims are patentable over Tsuchiya for all the same reasons as set forth above in traversal of Shiraishi.

With further regard to claims 7 and 10, these claims describe searching elements. The Examiner contends that once an analysis result is displayed, the results can be searched by a user’s visual inspection. However, Applicant submits that the operations provided by a user cannot teach features of an apparatus claim. In re Bell, 26 USPQ2d 1529 (Fed. Cir. 1993); see

¹ By this argument, we would not expressly concede that the reading of record for the recited means elements is necessarily correct.

RESPONSE UNDER 37 C.F.R. §1.111
U.S. Appln. No. 09/749,752

Attorney Docket No. Q61244

also Hewlett-Packard Co. v. Mustek Systems Inc., 67 USPQ2d 1825, 1829-30 (CA FC 2003).

Therefore, claims 7 and 10 are patentable for this additional reason.

With regard to claims 18-19, these claims describe more particularly the content of the management information. The Examiner has completely failed to indicate where these features are taught in the art, and thus clearly has not set forth a prima facie case of unpatentability.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

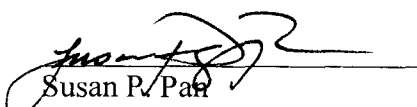
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